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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/601,819

06/23/2003

Joseph Raymond Faryniarz

J6830(C)

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7590

06/01/2006

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/601,819

Applicant(s)

FARYNIARZ ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/23/03, 6/23/03</u>   | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 3, 4, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ghisalberti et al. (WO 01/17486) as further evidenced by Lange's Handbook of Chemistry (1999) and The Merck's Index (1989).**

Ghisalberti et al. disclose a composition comprising deanol O-succinate and amino acids including glutamine and lysine in distilled water. See p. 24, Example 5. See instant claims 1, 3, 4, and 7. Deanol O-succinate is the dimethylethanolamine salt of succinic acid, a dicarboxylic acid.

Dimethylethanolamine has pKa of 9.26, while pKa of glutamine and lysine is 2.18 and 2.20, respectively. See Lange's Handbook of Chemistry, Table; Merck's Index, p. 702 and 882. See instant claim 5. Molecular weight of glutamine and lysine is 146.15 and 146.19, respectively. See Merck Index; instant claim 1 (ii).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokura (US 5641495) in view of Cosmetic Dermatology (Dermatology Times, February 2002, p. 78) and The Merck Index.**

Jokura teaches skin moisturizing composition comprising a combination a ceramide or pseudoceramides with a dicarboxylic acid and a salt of a dicarboxylic acid. See Malonic acid is among the particular example of dicarboxylic acids useful for the invention. See col. 3, lines 11 – 50; instant claim 2. The reference teaches to neutralize the acids with alkanolamines (triethanolamine), basic amino acids and ammonia. See Id.

While Jokura teaches using a mixture of amine salts, the reference does not specifically teach using dimethylethanolamine or a second amine which has a molecular weight of at least 149.

Cosmetic Dermatology teaches that topical administration of DMAE (dimethylethanolamine) combined with tyrosine improves deep wrinkles after 12 weeks of use, without any significant adverse side effects. See p. 78. See instant claims 7.

The Merck index teaches that molecular weight and pKa of tyrosine is 149 and 2.2, respectively. See p. 1548. See instant claims 3-6.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modify the composition of Jokura by adding DMAE and tyrosine as motivated by Cosmetic Dermatology because the latter teaches that these amine compounds improves deep wrinkle without side effects after a long-term use.

The skilled artisan would have had a reasonable expectation of successfully producing an anti-aging composition with good moisturisation and anti-wrinkle effects without irritation.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 6, and 7 of copending Application No. 10/347982 in view of Cosmetic Dermatology and Merck Index.**

Claim 1 of '982 application recites a cosmetic composition comprising a mono-hydroxy substituted amine salt of malonic acid and 1-99.9 wt-% of a cosmetically acceptable carrier. Claim 2 of the application limits the amine salt as DMAE.

The '982 application does not require a second amine as recited by the instant claims.

Cosmetic Dermatology, as discussed above, teaches that topical application of using DMAE and tyrosine improves deep wrinkle.

The Merck index teaches that molecular weight and pKa of tyrosine is 149 and 2.2, respectively. See p. 1548. See instant claims 3-6.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modified the invention of '982 application by further incorporating a second amine such as tyrosine as motivated by Cosmetic Dermatology because the latter teaches that tyrosine in combination with DMAE improves deep wrinkle upon long term use.

This is a provisional obviousness-type double patenting rejection.

**Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/374300 in view of Cosmetic Dermatology and Merck Index.**

Claim 1 of '300 application recites a cosmetic composition comprising a mono-hydroxy substituted amine salt of malonic acid and 1-99.9 wt % of a cosmetically acceptable carrier.

The '300 application does not require a second amine as recited by the instant claims.

Cosmetic Dermatology and Merck Index are discussed above.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modified the invention of '982 application by further incorporating a second amine such as tyrosine as motivated by Cosmetic Dermatology because the latter teaches that tyrosine in combination with DMAE improves deep wrinkle upon long term use.

This is a provisional obviousness-type double patenting rejection.

**Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 6, 10, 14, 15, and 16 of copending Application No. 10/601731 in view of Cosmetic Dermatology and Merck Index.**

Claim 1 of '731 application recites a cosmetic composition comprising a mono-hydroxy substituted amine salt of malonic acid and 1-99.9 wt % of a cosmetically acceptable carrier. Claim 2 of the application limits the amine salt as DMAE.

The '731 application does not require a second amine as recited by the instant claims.

Cosmetic Dermatology and Merck Index are discussed above.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modified the invention of '982 application by further incorporating a second amine such as tyrosine as motivated by Cosmetic Dermatology because the latter teaches that tyrosine in combination with DMAE improves deep wrinkle upon long term use.

This is a provisional obviousness-type double patenting rejection.

**Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/601856 in view of Cosmetic Dermatology and Merck Index.**

Claim 1 of '856 application recites a cosmetic composition comprising a mono-hydroxy substituted amine salt of malonic acid and 1-99.9 wt % of a cosmetically acceptable carrier. Claim 2 of the application limits the amine salt as DMAE.

The '856 application does not require a second amine as recited by the instant claims.

Cosmetic Dermatology and Merck Index are discussed above.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modified the invention of '856 application by further incorporating a second amine such as tyrosine as motivated by Cosmetic Dermatology because the latter teaches that tyrosine in combination with DMAE improves deep wrinkle upon long term use.

This is a provisional obviousness-type double patenting rejection.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 7:00AM until 4:30 PM.

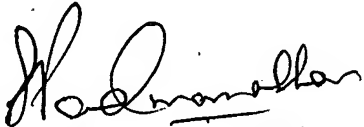


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Chi-Eun Yu  
Patent Examiner



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**